REMARKS

After entry of the present Amendment, claims 1-11 and 13-20 are pending in the subject application. Claim 11 is currently amended merely to correct a grammatical error as requested by the Examiner. Claim 12 is cancelled. No other claims have been amended or cancelled, and no claims are withdrawn, via the present Amendment. As such, no new matter is introduced via the present Amendment.

The Examiner has objected to the previously filed specification of the subject application and has requested a replacement specification with 1.5 or double spacing. Included herewith is a replacement specification which is double spaced pursuant to the Examiner's request.

The Examiner has objected to the language of claim 11, which included the erroneous phrase "any of claim 1." Claim 11 is currently amended pursuant to the Examiner's request to remove the words "any of."

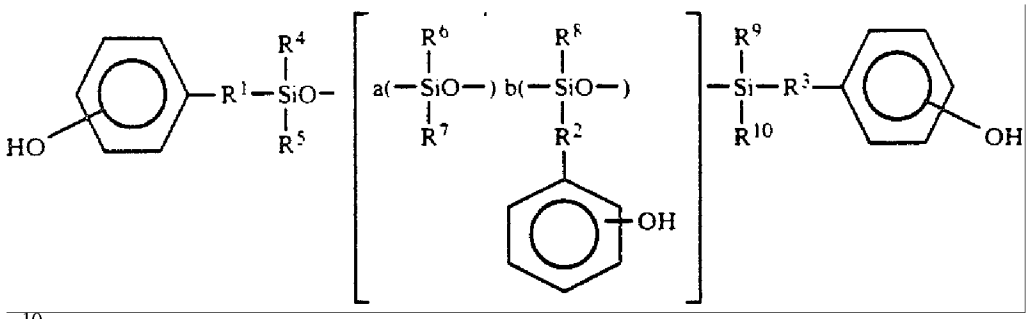
Claim 12 stands rejected under 35 U.S.C. §§ 101 and 112 for merely reciting a use of the product of claim 11. Claim 12 is cancelled in the present Amendment, thus obviating the Examiner's rejections of claim 12.

Claims 1-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,114,994 to Ito et al. (the '994 patent). As the Examiner is well aware, to properly establish anticipation under 35 U.S.C. §102, the reference must teach each and every element of that claim. See MPEP §2131. In addition, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A.

1970). For these reasons, the Examiner's rejections under 102(b) are respectfully traversed, as described in greater detail below.

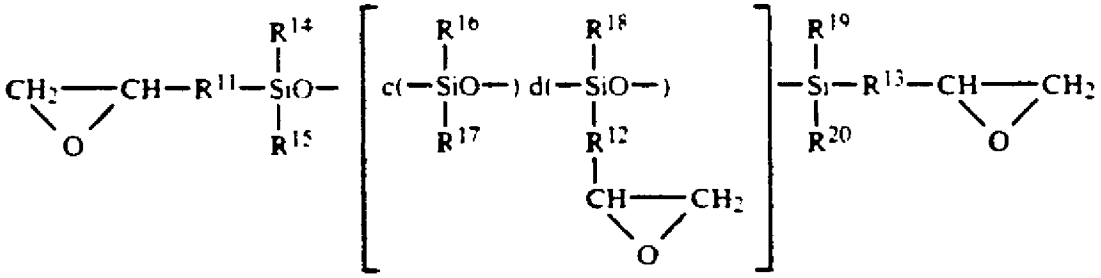
In particular, the Examiner contends that the '994 patent discloses an epoxy resin composition for sealing a semiconductor which contains a flexibilizer which is made from silicone containing hydroxyphenyl groups. The Examiner also contends that the silicone of the '994 patent is formed from a copolymer of a denatured silicone oil A having hydroxyphenyl groups and a denatured silicone oil B having epoxy groups.

Denatured silicone oil A of the '994 patent has the following general formula (I):



with R^1-R^{10} being defined in Column 2, lines 57-66 of the '994 patent.

Denatured silicone oil B of the '994 patent has the following general formula (II):



with R^{11}-R^{20} being defined in Column 3, lines 15-47 of the '994 patent.

The Examiner has correlated denatured silicone oil A of the '994 patent to claimed component (A) in the subject application, and has correlated denatured silicone oil B of the '994 patent to claimed component (B) of the subject application.

The Applicants respectfully note that component (A) of the subject application is expressly claimed to have a branched molecular structure. As readily understood by one of skill in the art, denatured silicone oil A of the '994 patent does **not** have a branched molecular structure. Instead, denatured silicone oil A of the '994 patent has a linear structure. In particular, as readily understood by one of skill in the art, T units, i.e., ($RSiO_{3/2}$) units, and Q units, i.e., ($SiO_{4/2}$) units, impart silicone chains (Si-O-Si) with a branched molecular structure. In contrast, general formula (I) above comprises only M units, i.e., ($R_3SiO_{1/2}$) units, and D units, i.e., ($R_2SiO_{2/2}$) units, which do not impart silicone chains with a branched molecular structure. More specifically with respect to the disclosure of the '994 patent, general formula (I) of the '994 patent, which is set forth above, consists of the following structure, in terms of its silicon units: M-D-D-M. M units are terminal units, and D units are bivalent linking units within the silicone chain (Si-O-Si). Clearly, denatured silicone oil A of the '994 patent, as represented by general formula (I), does not have a branched molecular structure, and the Examiner has failed to appreciate all of the elements of independent claim 1, particularly with respect to claimed component (A) having a branched molecular structure. As such, the Examiner has not established a proper rejection under § 102(b), and the Examiner's rejection is respectfully traversed.

Notwithstanding the above, the Applicants also note that dependent claims 3, 4, 13, and 14 expressly claim specific embodiments of the silicone unit formula for claimed component (A) (though clearly independent claim 1 is not limited to such specific embodiments), and these specific embodiments include either T units or Q units. In rejecting these dependent claims, the Examiner expressly admits that the '994 patent does not disclose $SiO_{4/2}$ units, i.e., Q units. The Applicants also note that the '994 patent also fails to teach, disclose, or even suggest $RSiO_{3/2}$ units, i.e., T units. The Examiner contends that "because either of instant formulas (1) or (2) may be used in the composition [of the '994 patent] without leading to unexpected results, the compositions of [the '994 patent] is deemed anticipatory over the claimed combination." (see pages 5-6 of the Non-final Office Action). Notably, the Examiner is improperly reading additional structure (i.e., branching) into denatured silicone oil A where it is clearly not present in general formula (I) of the '994 patent. Moreover and perhaps more importantly, the Applicants note that the unexpected results which the Examiner refers to are only relevant in the context of rebutting a rejection under § 103, and it is improper for an Examiner to even reference unexpected results in the context of making a rejection under § 102(b). See, e.g., MPEP § 2145. Arguing unexpected results is a method of rebutting a rejection under § 103 for Applicants; it is improper for the Examiner to argue that there are no unexpected results when the Applicants have not yet even attempted to make a showing of unexpected results, especially in the context of a rejection under § 102(b).

In view of the foregoing, the Applicants submit that claims 1-11 and 13-20 are both novel and non-obvious over the prior art, including over the '994 patent. As such, the Applicants

believe the subject application is in condition for allowance, and such allowance is respectfully requested.

The proper fee for a Petition for a One Month Extension of Time is included herewith. While it is believed that no additional fees are presently due, the Commissioner is authorized to charge the Deposit Account No. 08-2789, in the name of Howard & Howard Attorneys PLLC for any fees or credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS PLLC

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